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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
10/765,788	01/27/2004	Mary M. DaRif	6962D2	2592

7590 10/04/2004

The Sherwin-Williams Company  
11 Midland Bldg. - Legal Dept.  
101 Prospect Avenue, N.W.  
Cleveland, OH 44115

EXAMINER

FERNSTROM, KURT

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/765,788

Applicant(s)

DARIF ET AL.

Examiner

Kurt Fernstrom

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 20-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20,24-26 and 30-33 is/are rejected.
- 7) ☒ Claim(s) 21-23 and 27-29 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/27/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 25-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 25 ends with a semicolon rather than a period, thus making it unclear whether other limitations to the claim were inadvertently omitted.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20, 24-26 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drew in view of Teter. Drew discloses in Figures 1 and 3 and in the specification a method for comparing colors comprising selecting a color card 10 comprising a surface coated with a layer of a colored coating composition, and a plurality of perforations that define a chip section, which allow the chip section to be removed to form a window. Drew fails to disclose the step of placing the color card over an item such that the item is viewed through the window. (Rather, Drew discloses that

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the chip itself is placed upon an item for comparison. Teter discloses in column 4, lines 55-67 a method for comparing colors comprising a color card which is placed over an item so that the item can be viewed through a window in the card, and compared to a color surrounding the window. It would have been obvious to one of ordinary skill in the relevant art to modify the method disclosed by Drew by placing the card over an item and viewing the item through the window for the purpose of providing a more accurate visual perception of the color match. This motivation is explicitly discussed at column 4, lines 58-64 of Drew. While Drew does not explicitly discuss the use of its device in conjunction with "commercially available paint colors", such a feature would have been an obvious variation on Drew, which does disclose the use of the cards to match a color of a surface finish in an architectural or interior design setting. See column 1, lines 1-25.

Claims 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drew in view of Teter, and further in view of Edwards. Drew as viewed in combination with Teter discloses all of the limitations of the claims with the exception of the color card having a second surface coated with a color. However, it is known in the art of color comparison cards to provide colors on each side of the card, as disclosed for example by Edwards. It would have been obvious to one of ordinary skill in the relevant art to modify the method disclosed by Drew as viewed in combination with Teter by providing a color on a second surface for the purpose of increasing the number of colors and/or finishes that may be compared using a color card.

***Allowable Subject Matter***

Claims 21-23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: With respect to claim 21 (and its dependent claim 22), there is no disclosure or suggestion of a color strip having a plurality of color swatches thereon which is viewed through a window of a color card. While color strips having a plurality of color swatches thereon are generally well known in various devices and methods for comparing colors, there is no suggestion or motivation to use such a color strip in conjunction with the devices of Drew or Teter. The Teter device itself is a color strip having a plurality of color swatches thereon, however, the color strip itself has windows thereon through which items are viewed. Teter does not disclose or suggest a second color strip which is placed under the color card such that a plurality of colors may easily be viewed through a window in the color card. With respect to claim 3, there is no suggestion in

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Drew or Teter of a chip section which remains attached to the color card and is folded to create a window. There would be no reason to provide this feature in the device of Drew, since the chip sections themselves are placed upon items for comparison. While Teter does disclose the step of viewing an item through a window, Teter discloses small, circular chips which would not lend themselves to folding as recited in claim 23. As a result, claims 21-23 contain allowable subject matter.

### ***Double Patenting***

Claims 26-29 are objected to under 37 CFR 1.75 as being substantial duplicates of claims 20-23, respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Applicant is further advised that should claim 24 be found allowable, claim 30 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Simmons and Pestl disclose devices for comparing colors of materials.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (703) 305-0303. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KF  
September 29, 2004

**KURT FERNSTROM**  
**PRIMARY EXAMINER**

